

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00221
Patent 10,423,658 B2

Before LYNNE H. BROWNE, NORMAN H. BEAMER, and
KEVIN C. TROCK, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining Some Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner, Samsung Electronics Co., Ltd. (“Samsung”), has shown by a preponderance of the evidence that claims 1–13 of U.S. Patent No. 10,423,658 B2 (Ex. 1001, “the ’658 Patent”) are unpatentable, but has not shown by a preponderance of the evidence that claims 14 and 15 are unpatentable. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019).

A. Procedural History

The Petition (Paper 2, “Pet.” or “Petition”) requested *inter partes* review of the claims 1–15 of the ’658 Patent (the “challenged claims”). Patent Owner, MemoryWeb, LLC, filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply (Paper 8), and Patent Owner filed a Preliminary Sur-reply (Paper 9). Based upon the record at that time, we instituted *inter partes* review on all challenged claims on the grounds presented in the Petition. Paper 10 (“Institution Decision” or “Dec.”).

After institution, Patent Owner filed a Response (Paper 18, “PO Resp.”), Petitioner filed a Reply (Paper 22, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 34, “PO Sur-reply”).

On June 12, 2023, an oral hearing was held. The transcript of the hearing (Paper 39, “Tr.”) was entered in the record.

B. Real Party-in-Interest

Petitioner states that “Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. are the real parties in interest.” Pet. 108. Patent

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Owner states that it, MemoryWeb, LLC, is the real party in interest. Paper 3, 2.

C. Related Matters

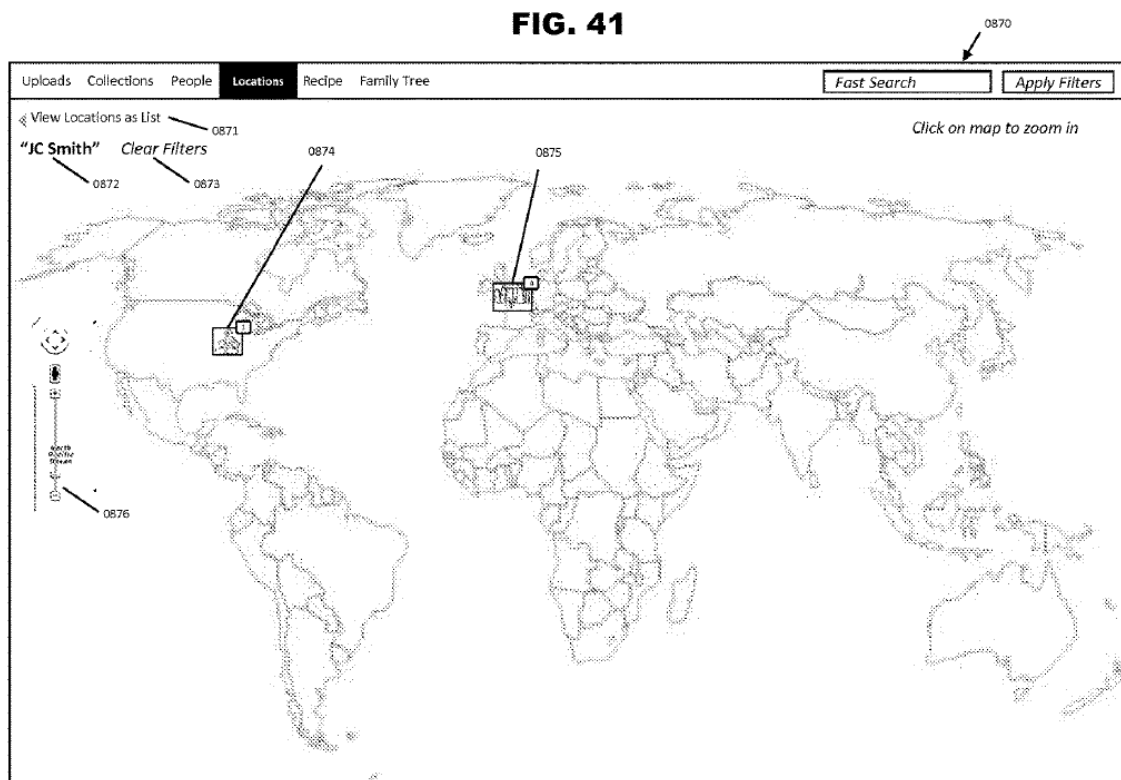
According to the parties, the '658 Patent was asserted in the following district court proceedings: *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, 6:21-cv-00411 (W.D. Tex.), Pending; *MemoryWeb, LLC v. Apple, Inc.*, No. 6-21-cv-00531 (W.D. Tex.), Pending; and *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, No. 1-21-cv-02666 (N.D. Ill.), Dismissed. Pet. 109; Paper 3, 2.

Petitioner states that “[t]he '658 patent is also the subject of an IPR proceeding filed by Apple Inc. (IPR2022-00033)” but that “Samsung is not a real party-in-interest to this IPR proceeding.” Pet. 109.

Patent Owner states that “[t]he '658 patent is related to the following U.S. Patents: 9,098,531 ('the '531 patent'); 9,552,376 ('the '376 patent'); 10,621,228 ('the '228 patent'); 11,017,020 ('the '020 patent'); 11,163,823 ('the '823 patent'), and 11,170,042 ('the '042 patent').” Paper 3, 2. Patent Owner additionally identifies the following IPR proceedings as related matters: *Samsung Electronics Co., LTD. v. MemoryWeb LLC*, IPR2022-00222 ('228 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00111 ('020 patent); *Apple Inc. v. MemoryWeb, LLC*, PGR2022-00006 ('020 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00033 ('658 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00032 ('376 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031 ('228 patent); *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413, ('228 patent); and U.S. Patent Application No. 17/459,933. *Id.* at 2–3.

D. The '658 Patent

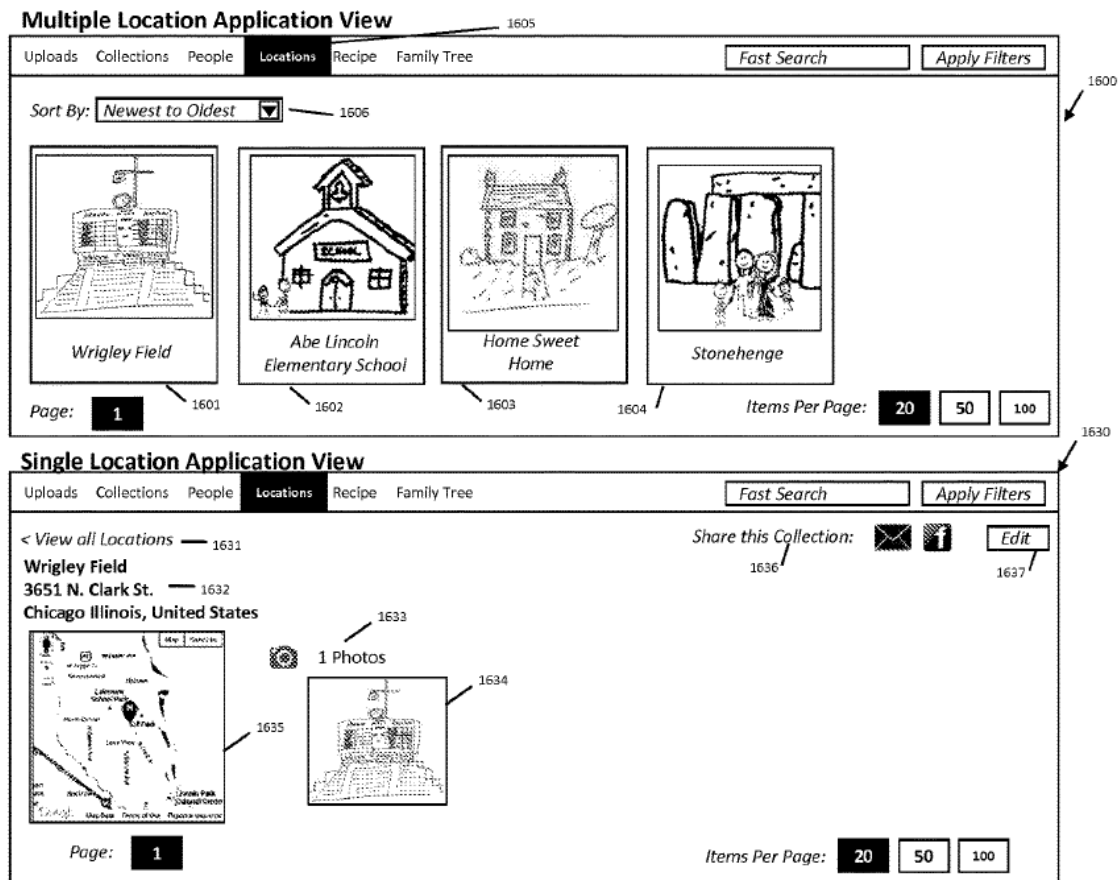
The '658 Patent relates to a computer-implemented system and method for managing and using digital files such as digital photographs. Ex. 1001, 1:16–19. In particular, the '658 Patent aims to provide an “interactive platform” for users to gather, organize, view, navigate, search, share and archive digital files, e.g., digital photographs and videos. *Id.* at 13:12–18, 13:56–59. The interactive platform may be provided via an “Application” having various “Application Views” for interaction with and organization of digital files. *Id.* at 8:59–9:7. A screenshot of an exemplary type of Application View, a “Location Application View,” is shown in Figure 41, reproduced below. *Id.* at 4:3–4.



As shown in the Location Application View interface of Figure 41, “Digital Files are displayed within an interactive map (Google map shown as

an example).” Ex. 1001, 29:25–29. Further, “[i]n this view, individual or groups of Digital Files are illustrated as photo thumbnails (see indicators 0874 and 0875) on the map and the user can select the thumbnail to see all the Digital Files with the same location.” *Id.* at 29:32–36. In the case that the user selects either one of the thumbnails, a “Single Location Application View” interface corresponding to the location is presented to the user, as shown in the bottom portion of Figure 34 reproduced below. *Id.*

FIG. 34



Focusing on the single location (1630) Locations Application View, an “individual location name is displayed at the top of the page (1632).” Ex. 1001, 24:22–24. The single location Locations Application View further displays “[t]humbnails of each Digital File within the specific collections” of

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